

### **REMARKS**

Favorable reconsideration and allowance of the present application in view of the foregoing amendments and the following remarks are respectfully requested.

Claims 1-4, 7-17, 19-22, 24-27, 29, and 44-45 are currently pending in the present application, including independent claims 1 and 22. Claims 5-6, 18, 23, 28, 30-43, and 47-49 were previously cancelled. Claim 46 has been cancelled in this paper.

Independent claim 1, for instance, is directed to an absorbent paper product for drying and conditioning the skin of a user. The paper product includes a paper web that is applied with a water-soluble lotion such that the add-on level of the lotion is between about 1% to about 10% by weight of the paper product. The lotion comprises water in an amount between about 10% to about 90% by weight of the lotion composition, a water-soluble skin conditioning component which includes glycerin in an amount between about 2% to about 15% by weight of the lotion composition, and a viscosity-increasing component in an amount between about 2% to about 10% by weight of the lotion composition.

In the Office Action, claims 1-4, 11, 13, 14-17, 19-22, 26-27, and 29 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over certain claims of copending Application Serial No. 09/717,939 entitled "Paper Products Treated With Oil-in-Water Emulsions." Without commenting on the propriety of this rejection, Applicants are submitting herewith a Terminal Disclaimer signed by the Assignee of the present application disclaiming the terminal part of the statutory term of any patent granted on this application extending beyond the expiration date of the term of any patent granted on Application Serial No. 09/717,939. Applicants are also submitting herewith the required Certificate Under 37 C.F.R. 3.73(b), since the Terminal Disclaimer is signed by the Assignee, Kimberly-Clark Worldwide, Inc. Thus, Applicants respectfully submit that the provisional rejection under the judicially created doctrine of obviousness-type double patenting is now overcome.

Claim 46 was rejected under 35 U.S.C. § 112, second paragraph, as vague and indefinite. The previous Office Action mailed on March 25, 2003 stated that claim 46

"depends from a claim that has been cancelled." Applicants have cancelled claim 46 in this paper.

Claims 1, 3, 4, 7, 8, 11-17, 19-21 and 44 were rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 00/64408. International Publication No. WO 00/64408 is a PCT publication, co-owned by the Assignee of the present application, Kimberly-Clark Worldwide, Inc., which has an international filing date of April 20, 2000 and a publication date of November 2, 2000. At pages 5-6, the Office Action indicated that "WO 00/64408 is still available as prior art under 35 USC 102(a)."

Applicants include with this Amendment a Declaration Under 37 C.F.R. § 1.131 signed by the inventors of the claimed subject matter in the present application, Jay C. Hsu, Ed Rosenthal, Richard L. Shick, and Audra S. Wright. This Declaration establishes that the inventors conceived the claimed invention prior to the effective date of the WO 00/64408 PCT publication, which is November 2, 2000. The Declaration also contains facts that establish due diligence on the part of the inventors of the claimed invention from prior to the effective date of the WO 00/64408 PCT publication to the filing date of the present application.

Applicants' submission of this Declaration is in no way an admission that WO 00/64408 either (1) anticipates the claims of the present application under any applicable section of 35 U.S.C. § 102 or (2) renders obvious, alone or in combination with other reference(s), the claims of the present application under 35 U.S.C. § 103. Applicants simply request that in light of the Declaration, WO 00/64408 be removed as prior art under § 102(a). This should render the rejection of claims 1, 3, 4, 7, 8, 11-17, 19-21 and 44 moot. Applicants respectfully submit that claims 1, 3, 4, 7, 8, 11-17, 19-21 and 44 are in condition for allowance.

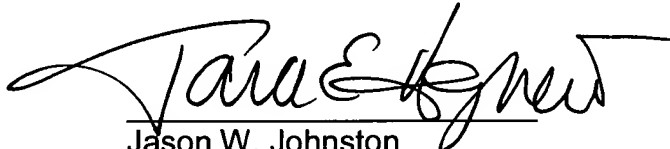
Additionally, claims 1-4, 7-12, 14-17, 19-22, 24-27, 29, and 44-45 were rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 98/03147 in view of WO 00/64408. At page 6, the Office Action specifically stated that claim rejections using WO 98/03147 as a prior art reference were "made in combination with WO 00/64408." In light of the fact that WO 00/64408 should be removed as prior art because of the Declaration Under 37 C.F.R. § 1.131 submitted herewith, the rejection of claims 1-4, 7-

12, 14-17, 19-22, 24-27, 29, and 44-45 should be rendered moot. Applicants respectfully submit that claims 1-4, 7-12, 14-17, 19-22, 24-27, 29, and 44-45 are in condition for allowance.

In summary, Applicants respectfully submit that all of the pending claims in the present application patentably define over all of the prior art of record and satisfy all of the requirements of 35 U.S.C. § 112. It is believed that the present application is in complete condition for allowance and favorable action, therefore, is respectfully requested. Examiner Wells is invited and encouraged to telephone the undersigned, however, should any issues remain after consideration of this Amendment. Otherwise, Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Please charge any additional fees required by this Amendment to Deposit Account No. 04-1403.

Respectfully submitted,  
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